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#7/dgm  
10-9-02  
Ret to  
Withdrawal  
Aband.

Docket No.  
428291/0014  
LR:RE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Etsuro Abe                      Examiner: Tawfik, S.  
Serial No.: 09/636,145                      Art Unit: 3721  
Filed: August 10, 2000                      Confirmation No. 6579  
For: CORRUGATING MACHINE AND CORRUGATING  
ROLL DESIGN FOR THE SAME

September 24, 2002

COMMUNICATION IN RESPONSE TO NOTICE OF ABANDONMENT

Commissioner for Patents  
Washington, D.C. 20231

Sir:

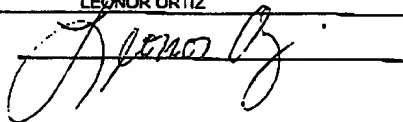
This communication is in response to the Notice of Abandonment dated August 23, 2002, for which applicant respectfully requests the withdrawal of this present application from abandonment.

Certificate of Transmission (37 C.F.R. 1.8)  
I hereby certify that this correspondence is being  
transmitted by facsimile to the Commissioner for Patents,  
Washington, D.C. 20231, on SEPTEMBER 24, 2002 at the following  
facsimile number (703) 305-3879.

Typed or printed name of person signing this certificate:

LEONOR ORTIZ

Signature



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REMARKS

Applicant received an Election/Restriction requirement from the United States Patent & Trademark Office with a mailing date of December 1, 2001. Applicant was given one (1) month to respond to the Election/Restriction requirement. A copy of said Election/Restriction requirement is attached hereto as Exhibit 1.

On February 1, 2002, Applicant timely responded to the outstanding office action with a "RESPONSE TO ELECTION REQUIREMENT", along with a Petition for Extension of Time under 37 CFR 1.136(a). A true and correct copy of the response and petition is attached hereto as Exhibit 2. As the Examiner will note, the Petition for Extension of Time indicated that the Commissioner was authorized to charge any fees which may have been required.


Applicant also filed its papers with a self-addressed, stamped postcard which was duly stamped received by the Office of Initial Patent Examination (OIPE) on February 20, 2002. A true and correct copy of the stamped postcard is attached as Exhibit 3.

On August 23, 2002, Applicant received a Notice of Abandonment (attached as Exhibit 4), which indicated that the reason for the abandonment was the "No reply has been received".

To the contrary, as evidenced above, Applicant timely filed a proper and complete response to the outstanding Election/Restriction requirement. In light of the foregoing, it is respectfully submitted that the subject application was improperly ruled abandoned. As such, Application hereby requests withdrawal of the application from abandonment.

If the Examiner is unable to withdraw the subject application from abandonment, the Examiner is respectfully requested to contact the undersigned. Early and favorable action is earnestly solicited.

Respectfully submitted,

 REG. NO. 48,874  
for Lawrence Rosenthal  
Registration No. 24,377  
Attorney for Applicant  
Stroock & Stroock & Lavan LLP  
180 Maiden lane  
New York, New York 10038  
(212) 806-6660

# Exhibit 1



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20501  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,145	08/10/2001	Etsuro Abe	428291/014	6579

7590 12/11/2001  
Stroock & Stroock & Lavan LLP  
180 Maiden Lane  
New York, NY 10038

EXAMINER

TAWFIK, SAMEH

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 12/01/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/636,145

Applicant(s)

ABE, ETSURO

Examiner

Samah H. Tawfik

Art Unit

3721

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correct on filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Application/Control Number: 09/636,145

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Art Unit: 3721

**DETAILED ACTION*****Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to a corrugating roll, classified in class 493, subclass 434.
- II. Claim 9, drawn to a double facer corrugating machine, classified in class 493, subclass 463.

The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)).

In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination require that depressions provided in the tops of the tooth tips of at least one of the corrugating rolls. The subcombination has separate utility such as each of the corrugating rolls having depressions provided in the tops of the tooth tips, first gluing means, first pressure means and second gluing means.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.



Application/Control Number: 09/636,145

Page 3

Art Unit: 3721

A telephone call was made to Mr. Richard Eskew Reg # 48874 on 11/14/2001 to request an oral election to the above restriction requirement, but did not result in an election being made.

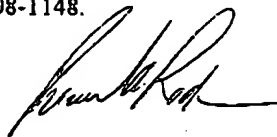
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameh H. Tawfik whose telephone number is (703) 308-2809. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rada, Rinaldi can be reached on (703) 308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 308-7769 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ST.  
November 14, 2001



Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700

Attachment for PTO-948 (Rev. 03/01, or earlier)  
6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.

## Exhibit 2

PTO/SB/22 (10-00)

Approved for use through 10/31/2002. OMB 0551-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)</b>		Docket Number (Optional) 428291/0014
In re Application of <u>Etsuro Abe</u>		
Application Number <u>09/636,145</u>		Filed <u>8/10/2000</u>
For <u>Corrugating Machine and Corrugating Roll Design...</u>		
Group Art Unit <u>3721</u>		Examiner <u>Tawfik, S.</u>

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.

The requested extension and appropriate non-small-entity fee are as follows (check time period desired):

☒ One month (37 CFR 1.17(a)(1)) \$ 110.00  
☐ Two months (37 CFR 1.17(a)(2)) \$ \_\_\_\_\_  
☐ Three months (37 CFR 1.17(a)(3)) \$ \_\_\_\_\_  
☐ Four months (37 CFR 1.17(a)(4)) \$ \_\_\_\_\_  
☐ Five months (37 CFR 1.17(a)(5)) \$ \_\_\_\_\_

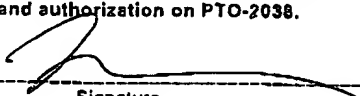
☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee amount shown above is reduced by one-half, and the resulting fee is: \$ \_\_\_\_\_.  
☐ A check in the amount of the fee is enclosed.  
☐ Payment by credit card. Form PTO-2038 is attached.  
☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account.  
☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 19-4709.  
 I have enclosed a duplicate copy of this sheet.

I am the ☐ applicant/inventor

☐ assignee of record of the entire interest. See 37 CFR 3.71.  
 Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96).  
☒ attorney or agent of record.  
☐ attorney or agent under 37 CFR 1.34(a).  
 Registration number if acting under 37 CFR 1.34(a) \_\_\_\_\_

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

February 1, 2002  
 Date

  
 Signature  
Lawrence Rosenthal  
 Typed or printed name

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ Total of \_\_\_\_\_ forms are submitted.

**Burden Hour Statement:** This form is estimated to take 0.1 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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## Exhibit 4



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20531  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/636,145	08/10/2000	Esuro Abc	428291/014	6579

7590 08/23/2002

Stroock & Stroock & Lavan LLP  
180 Maiden Lane  
New York, NY 10038

EXAMINER

TAWFIK, SAMEH

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 08/23/2002


Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Notice of Abandonment</b>	Application No.	Applicant(s)	
	09/636,145	ABE, ETSURO	
	Examiner	Art Unit	
	Sameh H. Tawfik	3721	

**— The MAILING DATE of this communication appears on the cover sheet with the correspondence address—**

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 12/01/2001.
  - (a) ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - (b) ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - (c) ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - (a) ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - (b) ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - (a) ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

  
**EUGENE KIM**  
**PRIMARY EXAMINER**

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

## STROOCK

## FACSIMILE

DATE

September 24, 2002

TO	COMPANY NAME	FAX NO.	PHONE NO.
Examiner S. Tawfik	U. S. Patent and Trademark Office Washington, D.C.	1-703-305- 3579	1-703-308- 2809

TOTAL NO. OF PAGES

21

FROM	Lawrence Rosenthal
SENDER'S FAX NUMBER	212-806-6006
SENDER'S PHONE NO.	212-806-6660
SENDER'S EMAIL	LRosenthal@stroock.com
ROOM NO.	38M
ATTORNEY NO.	1566
CLIENT/MATTER NAME	
CLIENT/MATTER NO.	428291/0014

FAX RECEIVED

SEP 24 2002

CJUP 3700

## MESSAGE

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Docket No.  
429291/0014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: ETSURO ABE

Art Unit: 3721

Application No.: 09/636,145

Examiner: TAWFIK, S.

Filed: August 10, 2000

For: Corrugating Machine and Corrugating Roll Design...

Date: September 24, 2002

Commissioner for Patents  
Washington, DC 20231

**CERTIFICATE OF TRANSMISSION**  
**BY FACSIMILE (37 C.F.R. § 1.8)**

Sir:

I hereby certify that the following correspondence  
**COMMUNICATION IN RESPONSE TO NOTICE OF ABANDONMENT AND EXHIBITS**

is being transmitted by facsimile to the United States Patent and Trademark Office in accordance  
with 37 C.F.R. § 1.8 on the following date: September 24, 2002 at the following  
facsimile number (703) 305-3579.

**Leonor Ortiz**

(Typed Or Printed Name Of Person Signing This Certificate)

  
(Signature)

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